

Marked up version of title page showing deletions and additions.

Deletions are enclosed in brackets in blue print while additions are underlined in red print.

Application of

Herbert M. Straub,

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and

Timothy D. Ryan

Joint Inventors

Docket

20003

for

UNITED STATES LETTERS PATENT

on

DECORATIVE MOLDING, DECORATIVE OVERLAYS AND ~~FOILS~~ FILMS
THEREFOR AND METHODS AND APPARATUS FOR MAKING THE SAME

Straub, et al., Docket 20003

6

July 08, 2002

Version of amended claims showing deletions and additions.

Deletions are enclosed in brackets in blue print while additions are underlined in red print.

1. (amended) A decorative molding wrapping ~~{foil}~~ film for decorating a molding, said decorative molding wrapping film comprising at least one hot transfer inked foil carried on a carrier~~{,}~~ having said at least one said hot transfer inked foil laminated onto a planar wrapping ~~{foil}~~ film thereby creating ~~{a laminated}~~ said decorative molding wrapping {foil} film wherein said ~~{laminated}~~ carrier is removed from said decorative molding wrapping film and said decorative molding wrapping {foil} film is wound upon a roll for use in ~~{foil}~~ wrapping of a substrate~~{ for use as picture frame element or building trim piece}~~.

2. (amended) A decorative molding wrapping film ~~{foil}~~ as in claim 1 wherein said ~~{laminated}~~ decorative molding wrapping {foil} film has ~~{said carrier stripped therefrom, said laminated wrapping foil thereby becoming an intermediate layered foil, layering}~~ at least one other hot transfer foil layered onto said ~~{intermediate layered}~~ decorative wrapping {foil} film thereby creating ~~{a laminated}~~ said decorative molding wrapping {foil} film wherein said ~~{laminated}~~ carrier is removed from said decorative molding wrapping film and said decorative molding wrapping {foil} film is wound upon a roll for use in ~~{foil}~~ wrapping of a substrate~~{ for use as picture frame element or building trim piece}~~.

3. (amended) A decorative molding wrapping film ~~{foil}~~ as in claim 2 wherein said ~~{laminated}~~ decorative molding wrapping {foil} film has ~~{said carrier stripped therefrom for application to a substrate, said laminated wrapping foil having}~~ an adhesive applied to a side of said ~~{layered}~~ decorative molding wrapping {foil} film opposite said one other hot transfer foil, said ~~{laminated}~~ decorative molding wrapping {foil} film wrapped about a substrate to be decorated.

4. (amended) A decorative molding wrapping film ~~{foil}~~ as in claim 1 wherein said ~~{laminated}~~ decorative molding wrapping {foil} film has ~~{said carrier stripped therefrom for application to a substrate, said laminated wrapping foil having}~~ an adhesive applied to a side of said ~~{layered}~~ decorative molding wrapping {foil} film opposite said hot transfer foil, said ~~{laminated}~~ decorative molding wrapping {foil} film wrapped about a substrate to be decorated.

5. (amended) A decorative molding wrapping film ~~{foil}~~ as in claim 1 wherein said at least

one said hot transfer inked foil is a translucent hot transfer foil.

6. (amended) A decorative molding wrapping film {foil} as in claim 1 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

7. (amended) A decorative molding wrapping film {foil} as in claim 2 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

8. (amended) A decorative molding wrapping film {foil} as in claim 7 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.

9. (amended) A decorative molding wrapping film {foil} as in claim 2 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.

10. (amended) A decorative molding wrapping film {foil} as in claim 9 wherein said at least one said other said hot transfer inked foil is a translucent hot transfer foil.

11. (amended) A decorative molding wrapping film {foil} comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil laminated onto an embossed wrapping film {foil} thereby creating a laminated embossed wrapping film {foil} wherein said carrier is removed from said laminated embossed wrapping film and said embossed laminated wrapping film {foil} is wound upon a roll for use in {foil} wrapping of a substrate[for use as picture frame element or building trim piece].

12. (amended) A decorative molding film {foil} as in claim 11 wherein said embossed laminated wrapping film {foil} has ~~{said carrier stripped therefrom, said embossed laminated wrapping foil thereby becoming an intermediate embossed layered foil, layering}~~ at least one other hot transfer foil layered onto said ~~{intermediate}~~ embossed layered film {foil} thereby creating a laminated embossed wrapping film {foil} wherein said carrier is removed from said laminated embossed wrapping film and said laminated embossed wrapping film {foil} is wound upon a roll for use in {foil} wrapping of a substrate[for use as picture frame element or building trim piece].

13. (amended) A decorative molding film {foil} as in claim 12 wherein said laminated embossed wrapping film {foil} has ~~{said carrier stripped therefrom for application to a substrate, said laminated embossed wrapping foil having}~~ an adhesive applied to a side of said laminated embossed wrapping film {foil} opposite said one other hot transfer foil, said laminated embossed

wrapping film {foil} wrapped about a substrate to be decorated.

14. (amended) A decorative molding film {foil} as in claim 11 wherein said laminated embossed wrapping film {foil} has ~~said carrier stripped therefrom for application to a substrate, said laminated embossed wrapping foil having~~ an adhesive applied to a side of said laminated wrapping film {foil} opposite said hot transfer foil, said laminated embossed wrapping film {foil} wrapped about a substrate to be decorated.

15. A decorative molding film {foil} as in claim 11 wherein said at least one said hot transfer inked foil is an opaque hot transfer foil.

16. A decorative molding film {foil} as in claim 11 wherein said at least one said hot transfer inked foil is a metallic hot transfer foil.

17. A decorative molding film {foil} as in claim 11 wherein said at least one said hot transfer inked foil is a translucent hot transfer foil.

18. A decorative molding film {foil} as in claim 12 wherein said at least one said hot transfer inked foil is an opaque colored hot transfer foil.

19. A decorative molding film {foil} as in claim 12 wherein said at least one said other hot transfer inked foil is a metallic hot transfer foil.

20. (amended) A decorative molding wrapping film {foil} comprising at least one hot transfer inked foil carried on a carrier, said at least one said hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto a planar wrapping film {foil} thereby creating a laminated wrapping film {foil} having portions of the base color of said planar wrapping film {foil} showing therethrough wherein said carrier is removed from said laminated wrapping film and said laminated wrapping film {foil} is wound upon a roll for use in {foil} wrapping of a substrate[for use as picture frame element or building trim piece].

FEES:

Applicants have amended claims 1 - 20 such that a total of 3 independent claims and 17 dependent claims remain in this application. It is believed by Applicants that no additional fees are required, however, Applicants respectfully request prompt notification in case missing fees are required in order correct such deficiency in a timely manner so that this amendment will be fully responsive on the effective date thereof.

REMARKS:

This amendment is for the purpose of amending the Specification in the original application by amending claims 1 - 10 to render the claims definite, amend claims 1, 2, 11, 12 & 20 to remove use specific language therefrom, amend claims 3 - 10 and 13 - 19 to be consistent with the language and form of the previous claims in each chain and provide traverse of the rejections advanced by the Examiner, first with regard to claims 1 - 10 and separately with regard to claims 1 - 20, so that claims 1 through 20 remain in this application.

The Official Action rejects claims 1 - 10 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter. Specifically, in claim 1, the Examiner states that it is not clear if "a decorative molding wrapping foil" or a "created laminated wrapping foil" is being claimed. Also in claim 2, the Examiner states that it is not clear if the "decorative molding foil", the "laminated wrapping foil", or the "intermediate layered foil" is being claimed as the invention. First, Applicants believe that it would be helpful to set forth the many uses of the words "foil" and "film" and distinguish between these words here to alleviate some common confusions.

Decorative wrapping foils are defined as "cellulose papers weighing between 40 and 200 grams per sq. meter... impregnated with a blend of resins..." though these impregnated papers "...do not require a topcoat to be considered a foil."

Laminating Materials Association, Inc. at www.lma.org.

Decorative wrapping foils may be provided with or without a top coat.

Hot transfer foils are an ink layer removably affixed to a carrier and "involve the

transfer of a complete coating system from a carrier film to a substrate by means of heat and pressure. When transferred at the point of contact between heated roller and substrate, the coating system provides both a decorative effect and a protective layer to provide specified end use properties. The foils are gravure printed in reverse sequence on a co-polymer film.”

www.lma.org

“A metallic or pigmented coating on plastic sheets or rolls used in foil stamping and foil embossing” is defined as a foil by PrintUSA at www.PrintUSA.com and thus the coating system may be either metallic or pigmented. Further, as found here, the coatings themselves are oftentimes referred to as foils.

The Foil Center at www.foilcenter.com defines foils as “flat-rolled products 0.0059 inches or less in thickness.” Thus, the substrate may also be called a foil wherein the most common use of the term foil is a reference to Aluminum foil.

Emboss: “press an image into paper so it lies above the surface. Also called cameo and tool.”

www.printindustry.com/glossary.htm

“Embossing - A process performed after printing to stamp a raised (or depressed) image into the surface of paper, using engraved metal embossing dies, extreme pressure, and heat. Embossing styles include blind, deboss and foil-embossed.”

www.ou.edu/special/printing/glossary.html

“Vinyl Film, made of polyvinyl chloride (PVC), is used for decorative surfacing and may be either clear or solid color. If it is clear, it is printed on the reverse side to protect the print. If it is a solid color, the printing is on the top. Vinyl films are divided into six categories.”

www.lma.org

One film is a wrapping film.

“Wrapping Films are calendered or extruded rigid vinyl films in gauges from

.005" to .010" (127.0 - 254.0 μ m). Film may be printed in wood grain or decorative patterns. Films may be embossed and may be coated with scratch and stain resistant coatings and primed to promote adhesion. Films are designed for wrapping profiles and can also be flat laminated and miterfolded."

www.lma.org

Unfortunately, Applicants used the terms "foil" and "film" interchangeably throughout the specification as commonly occurs in the industry, wherein, in fact, "film" should be used in the sense of a polymeric or paper sheet used to wrap around a substrate as in the definition of "vinyl wrapping films" in the definitions provided by the Laminating Materials Association shown above whereas "foils" should be used for the thin transfer product deposited on a carrier and thereafter transferred to a substrate in a transfer process. Applicants should have used these terms properly in the specification and claims and, therefore, in this amendment to the claims and throughout the remarks will use "film" to denote a sheet to be wrapped about a substrate, "foil" to indicate a transfer product and "carrier" to indicate the backing sheet for a "foil".

Returning to the rejection based on 35U.S.C. 112, second paragraph, Applicants have amended claims 1 - 10 to recite that the "decorative molding wrapping film" is the claimed element and that terms deemed to be indefinite have been deleted from the claims. (emphasis added) Applicants aver that the claimed element is a "decorative molding wrapping film" as the decorative molding wrapping film is a wrapping film for wrapping about a decorative molding substrate. The claimed element, a "decorative molding wrapping film," is thus a previously prepared plain wrapping film (usually already painted, hot ink transferred or otherwise covered with one layer of decoration) having a hot transfer foil laid upon and transferred to the surface of the plain wrapping film, stripping the carrier from the hot transfer foil and thereafter wrapped into a roll for later use in wrapping a substrate. Applicants have further amended claims 11 - 20 to recite that it is a "decorative molding film" that is the claimed element. As will be discussed below with reference to the cited prior art, Applicants will show that none of the prior art includes a previously prepared wrapping film having at least one hot transfer inked foil laminated thereonto and therefore Applicants believe that claims 1 - 20 distinguish over all the prior art. Having amended claims 1 - 10 to remove indefinite elements therefrom, Applicants

believe that claims 1 - 10 now have been put in condition for allowance and respectfully request reconsideration and allowance thereof.

The Official Action rejects claims 1 - 20 under 35 U.S.C. 103(a) as being unpatentable over Suess, et al., U. S. Patent 5,985,078 in view of Abrams, U. S. Patent 5,908,527. Applicants respectfully provide traverse of the Examiner's rejections based on Suess, et al., in view of Abrams, '527, as follows. Bearing the above definitions in mind, the double printed hot transfer foil etched by Suess, et al., is merely one of a multitude of hot transfer foils, but it is not a metallic pigmented hot transfer foil but rather a lacquer, according to Suess, et al., more commonly called an "ink." In Suess, et al., the metallic foil is only recited as a carrier along with plastic carriers, not as the transfer coat. See at line 52 in column 2 and again in column 3 at line 16, wherein the only two references to metal in Suess, et al., refer to the carrier. It is believed by Applicants that Suess, et al., use the words "embossed foils" to indicate the standard hot transfer foil widely used in the industry because Suess, et al., do not refer at any time to raising or depressing the surface using heat and pressure but rather describe the common practice of transferring an ink (lacquer) to a machine face causing the ink layer(s) to be released from the carrier. Now referring to column 3, in lines 62 - 67, Suess, et al., are merely describing the well known process of applying the ink, paint or lacquer layers to the polyester backing carrier including the adhesive layer, column 5, line 1, for use in the various industries. In column 4, lines 29 - 35, Suess, et al., are merely describing the known processes of transferring the ink, paint or lacquer layers to a machine. The decorative pattern referred to in Suess, et al., in column 4, lines 56 - 58 and in column 7, lines 14 - 16 is by virtue of the etching of Suess, et al., and cannot be asserted to include all decorative patterns as such an assertion would be greatly broadening the disclosure of Suess, et al. As stated above, Suess, et al., use the term 'foil' to indicate standard hot transfer foils of the industry. In fact, these various hot transfer foils are used by Applicants in decorating the decorative wrapping films of this invention. Suess, et al., do not decorate another decorative film, and specifically do not transfer ink layer(s) to decorate a decorative wrapping film but merely etch the outer layer of the double printed hot transfer foil after transferring the coating system from the double printed hot transfer to the machine. Thus, beginning at the machine, Suess, et al., have only a substrate (the

machine), an adhesive layer, a second colored lacquer layer, a first colored lacquer layer (subsequently etched) and a protective lacquer layer thus describing the common transfer process. The improvement of Suess, et al., is to etch the outer layer(s) after transferring the ink and removing the carrier. Applicants, however, provide an adhesive, a decorative wrapping film, wherein a top coat may have been previously applied to the decorative wrapping film, an adhesive layer, at least one hot transfer foil of lacquer, print or ink layered upon the original decorative wrapping film as a new decorative wrapping film as claimed in claims 1 - 20, whereafter this new decorative wrapping film is to be wrapped about a separate substrate in a subsequent wrapping operation. Applicants have the hot transfer ink foils transferred from the carrier in the process of applying same to the decorative wrapping film to make the decorative wrapping film of this invention whereas in Suess, et al., the lacquers are either attached to the carrier prior to etching or to the machine during and after etching and thus the lacquers do not exist as a separate intermediate product. Thus, the commonly known foils described in Suess, et al., are used by Suess, et al., to etch the outer layer but are used by Applicants to decorate another decorative surface, that is, the decorative wrapping film whether the decorative wrapping film has a top coat thereon or not. Suess, et al., is therefore inapplicable to the disclosure of Applicants and thus the combination with Abrams, '527, is moot, however, Applicants also wish to differentiate the instant disclosure with that of Abrams, '527.

Abrams, '527, uses the term 'foil' in the common sense, that is, an aluminum foil sheet. Applicants have admitted both the Abrams, patents, '527 and '844 as multi-layered laminate coverings for packages wherein both sides of a plastic material have printing thereon wherein a first surface is printed and overlaid with an adhesive with this surface then applied to an aluminum foil web. The second surface of the plastic carrier is then printed, overlaid with a lacquer and a dry bond adhesive applied to the lacquer layer. Note that Abrams, '527 and '844, retains the plastic carrier over the first printing. Applicants, on the other hand, remove the carrier in the process of transferring the hot transfer ink foils to the surface of the decorative wrapping film and thus Abrams, '527 or '844, does not teach, suggest or claim that a new decorative wrapping film is created by the marriage of a decorative wrapping film with at least one hot transfer foil as claimed by Applicants. The aluminum foil of Abrams, '527 and '844, is

just that, a sheet of aluminum foil to be used to cover the blister pack and not to be wrapped about a substrate. The structure of Abrams, '527 and '844, is not a decorative wrapping film as it has no decoration and cannot be asserted to include a decorative pattern as such an assertion would be greatly broadening the disclosure of Abrams, '527 and '844. Simply put, Suess, et al., have only a substrate (the machine) with one layer of ink(s) and no carrier, Abrams, '527 and '844, has a substrate, an aluminum foil covering, a carrier with printing on both sides while Applicants have the substrate, a decorative wrapping film with additional decorative ink(s) on the decorative wrapping film having removed the carrier in the process of transferring the ink(s). Suess, et al., in view of Abrams, '527, would teach the substrate (blister pack) of Abrams, '527, the aluminum foil of Abrams, '527, the ink(s) of Suess, et al., with the outer layers of ink having been etched after application to the aluminum foil and the blister pack. Applicants provide a joinder of two decorative films, the decorative wrapping film and the at least one hot transfer foil. In claims 11 - 19, Applicants use an embossed decorative film, that is, a wrapping film with actual raised and lowered portions created by an embossing process as the decorative wrapping film, which is then further married to at least one hot transfer foil to decorate the embossed surfaces, quite unlike either Suess, et al., Abrams, '527 or '844, or Suess, et al., in view of Abrams, '527. To apply the etching of the ink of Suess, et al., to the plain aluminum foil of Abrams, '527, and assert that this combination is Applicants' invention greatly broadens both Suess, et al., and Abrams, '527 and '844. Thus, Applicants believe that the instant invention is fully patentable over Abrams, '527, or Suess, et al., or Suess, et al., in view of Abrams, '527. Applicants respectfully request reconsideration and allowance of claims 1 - 20.

The Official Action rejects claims 1 - 10 under 35 U.S.C. 103(a) as being unpatentable over Abrams, U. S. Patent 5,653,844 in view of Nelson, U. S. Patent 4,724,026. Applicants respectfully provide traverse of the Examiner's rejections based on Abrams, '844 in view of Nelson as follows. Applicants have previously set forth that Abrams, '527 is inapplicable standing alone or in combination with Suess, et al., as Abrams, '527 cites only printing on both sides of a thermoplastic outer layer adhesively applied to an aluminum foil which is then applied to a blister package. Abrams, '844, recites the same disclosure and thus the structure, method and use is the same as in Abrams, '527. Thus, it is clear to those in the industry that the

disclosure of Abrams, '844, is an **aluminum** foil laminate, not a decorative wrapping film.(emphasis added) To apply Abrams, '844, to the decorative wrapping industry is to extend the monopoly enjoyed by Abrams, '844, in the packaging industry to all other industries. Similarly, Nelson is a process of enhancing the tops of printed characters and thus only selectively applies a metallic pigmented hot transfer coating on small xerographic images applied to paper in a xerographic process. Nelson provides the adhesive to adhere to xerographic images and thus provides only a metallic pigmented hot transfer foil coating carried on a carrier as is well known in the art. As with Suess, et al., Nelson uses a commercially available hot transfer foil, wherein the hot transfer foil is a metallic pigmented hot transfer foil in place of the ink layers. In one embodiment, the commercially available metallic pigmented hot transfer foil referred to in Nelson is also used on the various wrapping films in Applicants' disclosure to provide for the novel decorative wrapping film. Furthermore, Nelson does not wrap the xerographic sheet as a decorative wrapping film around a substrate nor does Nelson discuss, suggest or claim such a structure or process. Nelson is a printed sheet and only a printed sheet. Merely having a metallic pigmented face on the characters does not extend Nelson into the other industries nor does combining Nelson with Abrams, '844,. Nelson, alone, comprises a printed paper with a metallic pigmented coating on the printing wherein the printing and the additional metallic pigmented coating on the print cover a minor portion of the sheet of paper, typically on the order of 5 - 20 %, the remainder being discarded. Applicants provide coverage over a substantial portion of the decorative wrapping film. In Nelson, it is the print that accepts the metallic pigmented foil, not the metallic pigmented foil that accepts the print and therefore most of the hot transfer metallic pigmented foil is lost.

Abrams, '844, comprises a substrate (the blister pack), an aluminum foil covering, a carrier with printing on both sides again with only 5 - 20 % coverage as is typical in printing of characters. Abrams, '844, in view of Nelson would then have printing on both sides of a paper sheet with a metallic pigmented coating on the tops of the characters covering only a minor portion of the surface area of either side, the structure then applied to a blister pack, not wrapped about a substrate. Obviously, the enhanced portions of the characters on the inside against the aluminum foil would be hidden from view. Thus, Abrams, '844, in view of Nelson

does not suggest, teach or claim the unique combination of Applicants wherein one decorative wrapping film is further decorated with at least one hot transfer foil applied thereto and therefore, Applicants believe that claims 1 - 10 now stand allowable. Applicants believe that the traverse here presented clearly shows that none of the patents cited by the Examiner, standing alone or in any combination, are applicable to Applicants disclosure and therefore, Applicant firmly believe that the rejections advanced by the Examiner have been overcome. Applicants respectfully request reconsideration and allowance of claims 1 - 20.

Applicants have amended claims 1 - 10 to overcome the Examiner's rejection of claims 1 - 10 based on 35 U.S.C. 112, second paragraph, have further amended claims 1, 2, 11, 12 and 20 to remove the specific use language, have amended claims 1 - 20 to change the word "foil" to "film" when referring to the decorative wrapping film, have provided traverse of the rejection of claims 1 - 20 based upon 35 U.S.C. 103(a) and further provided traverse of the additional rejection of claims 1 - 10 based upon 35 U.S.C. 103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 20 remain in this application and Applicants respectfully request allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

Respectfully submitted,

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